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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/792,100

03/03/2004

Giuseppe Maio

1610-100

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07/07/2009

AKERMAN SENTERFITT

P.O. BOX 3188

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EXAMINER

PURDY, KYLE A

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/792,100	Applicant(s) MAIO ET AL.	
	Examiner Kyle Purdy	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. The Examiner acknowledges receipt of the amendments filed on 03/16/2009 wherein claim 1 has been amended and claims 11-13 are newly added.

2. Claims 1, 2, 4 and 7-9 are presented for examination on the merits. The following rejections are made.

Election/Restrictions

3. Newly submitted claims 11-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new claims are use claims which are distinct from the composition claims as originally elected.

4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-13 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. It should be noted that 'use' claims do not fall under any statutory category according to the MPEP.

Response to 132 Declaration

6. The declaration under 37 CFR 1.132 filed 03/16/2009 is sufficient to overcome the rejection of claims 1, 2, 4 and 7-9 based upon Veeger et al. (US 6471983), evidenced by Kraton IR 401 in view of Viladot (20030044469). The declaration is sufficient to overcome the rejection

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by showing the use of polyisoprene imparts better properties, i.e. transfer resistance, appearance, etc., to cosmetic compositions that does polyisoprene latex.

Response to Applicants' Arguments

7. Applicants arguments filed 03/16/2009 regarding the rejection of claims 1, 2, 4 and 7-9 made by the Examiner under 35 USC 103(a) over Veeger et al. (US 6471983), evidenced by Kraton IR 401 in view of Viladot (20030044469) have been fully considered and they are found persuasive. This rejection has been overcome by the filed 132 declaration, discussed above.

New Rejections

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 2, 4 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

10. Applicant has amended claim 1 to recite a 'wherein the said cosmetic composition is an anhydrous composition'. While it is acknowledged that in Applicants specification and all

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exemplified compositions are devoid of the inclusion of water, Applicant does however include components into their compositions which are known to include water. For instance, alcohol is frequently diluted in water. Thus, it is not clear if the alcohol which Applicant is using is 100% pure alcohol, or some aqueous based dilution thereof. Clarification of the type of alcohol employed by the example is requested. This is a new matter rejection.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. **Claims 1, 2, 4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tournilhac et al. (US 2003/0059389; published 03/27/2003) in view of Gough et al. (US 5580550; published 12/03/1996) and Viladot et al. (US 2003/0044469; of record).**

14. Tournilhac is directed to cosmetic compositions for coating ketain fibers. The composition comprises a supple phase such as polyisoprene (see [0015]; see instant claim 1).

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The supple phase amounts to at least 10% of the multiphase particles which account for up to 70% of the composition (see claim 37). The composition is also to contain a hydrocarbon-based oil such as isododecane (see [0055]; see instant claim 1). The oil is present in an amount of between 1-95% (see [0058]; see instant claims 1 and 7). The composition is to also contain a wax or silicone. The composition is to also comprise filler such as kaolin clay. The composition is also to be anhydrous (see [0189]; see instant claim 1).

15. Tournilhac fails to teach the polyisoprene as having a molecular weight of between 2,000,000 and 4,000,000. Tournilhac also fails to teach the composition as possessing disteardimonium hectorite in an amount of between 0.005 to 20%. Finally, Tournilhac fails to teach the amount of wax and/or silicone contained by the composition.

16. Gough is directed to cosmetic compositions containing polymeric resins. A preferred polymeric resin is that of polyisobutylene with a preferred MW of between 150 and 10,000,000 (see column 3, lines 25-50; see instant claims 1, 2 and 9). The amount of polyisoprene included in the composition is from 0.01 to 20% (see column 4, lines 25-35). It's taught that such a resin is useful for providing the cosmetic composition with the ability to impart more tactile and visual benefits as well as imparting a thicker feel and enhanced body when applied to hair (i.e. lashes) (see column 2, lines 55-65).

17. Alwattari is directed to cosmetic compositions which comprise various clays. The clays are taught to be useful in a variety of systems, including that of anhydrous compositions. It's taught that the organophilic clays are useful for imparting a water resistance to the applied cosmetic composition. Exemplified clays include clay itself kaolin as well as modified clays such as Bentone 38 (distearyldimethylbenzylammonium hectorite; i.e. distearyldimonium hectorite)

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(see column 6, line 3). The amount of the clay present in the composition may range from 0.05 to 20%. Alwattari also teaches using waxes for providing thickness to the applied composition as well as preventing the composition from drying out post application. The wax is present in an amount of from 1-40% (see column 7, line 30-55; see instant claim 8).

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tournilhac, Gough and Alwattari with a reasonable expectation for success in arriving at a composition consisting of polyisoprene with a MW of between 2,000,000 and 4,000,000, disteardimonium hectorite, isododecane and other conventional cosmetic excipients, colourants and additives wherein the final composition is anhydrous. Tournilhac fails to teach a MW for polyisoprene, however, it would have been obvious for any person of skill in the art to look to any other known composition which uses the same in an attempt to identify which MW ranges were disclosed as being useful for that composition. If the result was the identification of a value as instantly claimed, then that would be a result of ordinary skill and common sense, not one of innovation. With that stated, the values of the art are recognized as to provide the composition with a thicker feel and enhanced body when applied to hair and improved tactile and visual benefits. In regards to the amount of polyisoprene included in the composition, this would have been an obvious value to determine. With respect to the inclusion of a disteardimonium hectorite, this is obvious. As Tournilhac stipulates the inclusion of a clay like substance, an ordinary person would endeavor to use this and/or substances similar to it. Thus, if the result was the finding of Alwattari's teaching that kaolin clays are functionally equal to modified clays such as Bentone-38 (instantly claimed material), then this would have been a product of ordinary skill and common sense to modify the

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Tournilhac with its inclusion. Additionally, one would have been motivated to use disteardimonium hectorite in the mascara composition of Tournilhac because Bentone-38 provides water resistance to the compositions. And while Tournilhac teaches that composition as including a waxy substance, it fails to teach how much of the wax the composition is to comprise. Alwattari teaches that its composition contains between 1-40% wax, which is sufficient to provide the composition with an improved thickening appearance and prevent drying after application of the composition. With respect to the requirement that the polyisoprene be comminuted, it is the position of the Examiner the comminuted polyisoprene is identical to polyisoprene which has not be comminuted. The resultant polyisoprene would still be polyisoprene with a molecular weight of somewhere between 2,000,000 and 4,000,000. The inclusion a process limitation for reducing polyisoprene particle size does not add any significant limitation to the claims which is not present or covered by the MW limitation. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
July 2, 2009*

*/David J Blanchard/
Primary Examiner, Art Unit 1643*